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7 IN RE: EX PARTE APPLICATION OF
8 HMD GLOBAL OY FOR AN ORDER
9 UNDER 28 U.S.C. § 1782 TO OBTAIN
DISCOVERY FOR USE IN FOREIGN
PROCEEDINGS

10 Case No. [25-mc-80022-EKL](#)
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28 **ORDER GRANTING EX PARTE
APPLICATION PURSUANT TO 28
U.S.C. § 1782**

Re: Dkt. No. 1

On February 3, 2025, HMD Global Oy (“HMD”) filed an *ex parte* application (“Application”) pursuant to 28 U.S.C. § 1782 for an order authorizing limited discovery from Apple Inc. (“Apple”) in connection with a pending legal action in Germany. Application, ECF No. 1 (“Appl.”). For the reasons set forth below, the Application is GRANTED.

I. BACKGROUND

The following facts are taken from the Application and supporting declarations. HMD is a Finnish company that develops, markets, and sells mobile devices worldwide. Appl. at 1. In 2022, Huawei Technologies Co., Ltd. (“Huawei”) filed three legal actions against HMD in the Munich District Court of Munich, Germany, asserting patent infringement claims and seeking prohibitory injunctions and the recall of products (the “German actions”). *Id.* at 2. HMD prevailed in two of the actions, and Huawei’s appeals in those actions are pending before the Munich Higher Regional Court; the third action remains pending before the Munich District Court. *Id.*

Under European law, a party asserting patent infringement claims must satisfy certain pre-filing obligations, including (1) alerting the alleged infringer of the infringement, and (2) if the alleged infringer seeks a licensing agreement, presenting a written offer for a license on terms that

1 are fair, reasonable, and non-discriminatory (“FRAND”). *Id.* at 1-2; *see also* Decl. of Andreas von
2 Falck ¶ 15, ECF NO. 1-1 (“von Falck Decl.”). If the patent holder fails to make a FRAND offer
3 before filing suit, *i.e.*, by offering licensing terms that are less than favorable, European courts will
4 find that the patent holder breached the “ND” portion of FRAND, and rule that the patent holder
5 cannot lawfully bring an action for a prohibitory injunction or the recall of products. Appl. at 2
6 (citing pre-litigation requirements set forth in *Huawei Techs. Co. Ltd. v. ZTE Corp.*, No. C-170/13,
7 ECLI:EU:C:2015:477, ¶ 60 (June 16, 2015)).

8 In the German actions, HMD asserted FRAND defenses, arguing that the license terms
9 offered by Huawei were significantly less favorable than the terms it offered to HMD’s
10 competitors, including Apple. *Id.* at 2-3. HMD contends that it sought production of Huawei’s
11 license agreements, but Huawei avoided HMD’s discovery efforts by utilizing a civil procedure
12 that allowed it to “cherry pick” and disclose certain license agreements with other companies that
13 are not HMD’s true competitors in the “relevant product market.” *Id.* at 3; von Falck Decl. ¶¶ 20-
14 24. HMD then sought an order requiring Huawei to produce its license agreements with
15 Qualcomm, a relevant competitor, but the German court denied the request. von Falck Decl.
16 ¶¶ 26-27. German procedural law does not provide any other discovery options, including
17 obtaining non-party discovery. *Id.* ¶ 28. Thus, HMD cannot obtain Huawei’s license with Apple
18 in the German actions. Appl. at 4; von Falck Decl. ¶ 28.

19 HMD contends that the requested discovery, the license agreement between Huawei and
20 Apple, is relevant to HMD’s defenses in the German actions. Specifically, HMD argues that it
21 will show that Huawei’s recent patent license to Apple provided materially better terms than were
22 offered to HMD, thus barring Huawei’s claims for injunctive relief or recall of products. Appl. at
23 1. HMD asserts that the German courts are likely to consider the agreements as evidence in both
24 the pending action and the actions on appeal. *Id.* at 4; von Falck Decl. ¶ 32.

25 HMD requests a subpoena demanding that Apple produce the following information:
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27 All agreements between [Apple] and Huawei, including the 2015 agreement referred
28 to on page 11 of the Huawei White Paper entitled “The Foundation of Innovation”
(2020),https://www-file.huawei.com/-/media/CORP2020/pdf/download/Huawei_IPR_White-paper_2020_en.pdf.

1 Decl. of Matthew S. Warren Ex. A, ECF No. 1-2 (“Subpoena”). HMD served Apple with the
2 Application and proposed Subpoena. ECF No. 10. On February 19, 2025, Apple filed a response
3 to the Application, stating that it “takes no position at this time on whether HMD’s Application
4 should be granted, but it reserves all rights in connection with any subsequent subpoena.” Apple
5 Resp. at 2, ECF No. 14 (“Resp.”). Apple asks that the order granting the Application “recognize
6 that Apple may move to quash or otherwise challenge the subpoena.” *Id.* at 3.

7 **II. LEGAL STANDARD**

8 Section 1782 states, in relevant part:

9 The district court of the district in which a person resides or is found may order him
10 to give his testimony or statement or to produce a document or other thing for use in
11 a proceeding in a foreign or international tribunal, including criminal investigations
12 conducted before formal accusation. The order may be made . . . upon the application
13 of any interested person and may direct that the testimony or statement be given, or
14 the document or other thing be produced, before a person appointed by the court.

15 28 U.S.C. § 1782(a). The purpose of § 1782 is “to provide federal-court assistance in gathering
16 evidence for use in foreign tribunals.” *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241,
17 247 (2004). Section 1782 permits district courts to authorize discovery “where three general
18 requirements are satisfied: (1) the person from whom the discovery is sought resides or is found in
19 the district of the district court where the application is made; (2) the discovery is for use in a
20 proceeding in a foreign or international tribunal; and (3) the application is made by a foreign or
international tribunal or any interested person.” *Khrapunov v. Prosyankin*, 931 F.3d 922, 925 (9th
Cir. 2019) (quoting 28 U.S.C. § 1782(a)) (internal quotation marks omitted).

21 A district court has discretion to authorize discovery under § 1782, but “is not required to
22 grant a § 1782(a) discovery application simply because it has the authority to do so.” *Intel*, 542
23 U.S. at 264. In *Intel*, the Supreme Court set forth four factors courts must consider in determining
24 whether and how to exercise their discretion: (1) whether “the person from whom discovery is
25 sought is a participant in the foreign proceeding”; (2) “the nature of the foreign tribunal, the
26 character of the proceedings underway abroad, and the receptivity of the foreign government or
27 the court or agency abroad to U.S. federal-court judicial assistance; (3) “whether the § 1782(a)
28 request conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of

1 a foreign country or the United States”; and (4) whether the request is “unduly intrusive or
2 burdensome.” *Id.* at 264-265. The district court’s exercise of discretion is informed by § 1782’s
3 “‘twin aims’ of ‘providing efficient assistance to participants in international litigation and
4 encouraging foreign countries by example to provide similar assistance to our courts.’” *Id.* at 252.

5 Courts commonly consider § 1782 applications on an *ex parte* basis because “parties will
6 be given adequate notice of any discovery taken pursuant to the request and will then have the
7 opportunity to move to quash the discovery or to participate in it.” *IPCom GMBH & Co. KG v.*
8 *Apple Inc.*, 61 F. Supp. 3d 919, 922 (N.D. Cal. 2014).

9 III. DISCUSSION

10 HMD has met all three threshold statutory requirements. First, Apple’s principal office is
11 in Cupertino, California. Appl. at 1. Thus, Apple is “found” in the Northern District of California
12 for purposes of § 1782. *Super Vitaminas, S.A.*, No. 17-mc-80125, 2017 WL 5571037, at *2
13 (noting that a business is “found” in the district where it is headquartered). Second, the discovery
14 is intended for use in the German actions. Appl. at 3. Third, as the defendant in the German
15 actions, HMD is an “interested person.” *Intel*, 542 U.S. at 256-57.

16 The Court finds that all four discretionary considerations set forth in *Intel* favor granting
17 the Application. First, Apple is not a participant in the German actions, so the discovery HMD
18 seeks will be outside the German courts’ jurisdiction. Appl. at 1. Second, HMD represents that
19 there are no known restrictions imposed by or policies under German law limiting U.S. federal
20 court judicial assistance for the purposes stated in the Application, and that German courts are
21 receptive to assistance from district courts concerning discovery. *See* von Falck Decl. ¶ 32
22 (indicating that if HMD were to introduce the Apple agreements in the German actions, the courts
23 “would take them into account and consider said agreements as evidence to decide on the FRAND
24 defense.”). Third, HMD represents that it is not attempting to circumvent any foreign proof-
25 gathering restrictions or other policies of Germany or the United States; neither the Application
26 nor the supporting materials suggest any evidence to the contrary. Appl. at 7; *see also In re*
27 *Illumina Cambridge Ltd.*, No. 19-mc-80215-WHO (TSH), 2019 WL 5811467, at *5 (N.D. Cal.
28 Nov. 7, 2019) (finding that an order authorizing discovery under § 1782 for use in a foreign

1 proceeding “would not offend any court or violate any court order in Germany[.]”). Fourth, the
2 discovery sought is not unduly burdensome because it is limited in scope to a specific set of
3 agreements between Huawei and Apple as defined in the Subpoena. *See Subpoena; see also* Resp.
4 at 2 (“Apple takes no position at this time on whether HMD’s Application should be granted[.]”).
5 Accordingly, the fourth factor is also satisfied.

6 **IV. CONCLUSION AND ORDER**

7 For the foregoing reasons, the Court GRANTS HMD’s Application for leave to serve a
8 subpoena on Apple. HMD shall serve a copy of this Order on Apple with the proposed Subpoena.
9 This Order is without prejudice to any argument that may be raised in a motion to quash or other
10 motion from Apple or Huawei.

11 **IT IS SO ORDERED.**

12 Dated: May 14, 2025



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15 Eumi K. Lee
16 United States District Judge
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